

REMARKS

Favorable reconsideration of the application is respectfully requested in light of the amendments and remarks herein.

Upon entry of this amendment, claims 1-20 and 71 will be pending. By this amendment, claims 1 and 6-9 have been amended and claim 71 has been added. No new matter has been added.

Claims Objections

Claim 1 is objected to because of a typographical error. This typographical error has been corrected in the amendment to claim 1.

Drawings

Corrected drawings have been submitted.

Rejections under 35 U.S.C. § 112

Claims 1-20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It appears the Office Action confuses the distinctions between *breadth* and *indefiniteness*. Claim breadth defines the extent to which the Office Action may interpret the terms for the purpose of anticipation and obviousness. Indefiniteness involves an

analysis of whether “in light of the specification” one of ordinary skill would be capable of understanding the claims.

It is a well held precept that claims are to be read in light of the specification when determining whether the claims are definite. *Allen Archery Inc. v. Browning Mfg. Co.*, 819 F.2d 1087, 2 USPQ2d 1490 (Fed. Cir. 1987). The MPEP has incorporated this precept stating that “[t]he meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification.” MPEP §608.01(o). The definiteness of the language must be analyzed not in a vacuum, but in light of the teachings of the prior art and the particular application disclosure. *In re Angstadt*, 537 F.2d 498, 190 USPQ 214, 217. A special meaning provided in the specification may supersede the ordinary meaning with respect to definiteness. *In re Morris*, 127 F. 3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997).

Paragraphs 10 and 12 of the Office Action assert that the limitation of claim 1 which recites “discrete instance[s]” and “bound instance[s]” are indefinite. However, the terms “discrete instance,” “bound instance,” “discrete license,” “discrete locked content data,” and “discrete license” do not have standard meanings within the art, and therefore must be interpreted for definiteness in light of the specification.

In this case the terms bound and discrete clearly refer to something beyond mere “Webster dictionary definitions.” In part, the specification defines discrete and bound instances in paragraph [0032] as provided:

[0032] ... an instance that is compliant with hub network operation is in one of two exclusive states: discrete or bound. **A discrete instance is independent of any hub network and can be played or presented through any compliant device (according to the license**

of the discrete instance). However, a compliant device cannot make a usable copy of a discrete instance. A discrete instance includes locked content data and a discrete license. The locked Content data of the discrete instance is referred to as the "discrete version" of the locked content data. The locked content data is locked by being protected from unauthorized access, such as by encryption. **A bound instance is bound to one hub network. The bound instance is one logical instance represented by locked content data and corresponding licenses stored on the server of the hub network and on zero or more of the clients of the hub network.** The locked content data stored by the server is the source for copies of the content data in the hub network and is the "source version." Copies of the source version content data are stored on clients and are "sub-copy versions" (though some or all of the data in the discrete version, the source version, and/or any of the sub-copy versions can be the same). **A bound instance can only be played or presented through a compatible compliant device that is a member of that hub network. Members of that hub network can make sub-copies of the content data of a bound instance.**

Given the definitions from the specification, the terms "discrete" and "bound" are sufficiently definite. From the above, it is clear that the term "bound" does not mean simply "internal to the hub network" as suggested by the Office Action, but instead refers to an **"instance [that] can only be played or presented through a compatible compliant device that is a member of that [instance's] hub network."** Bound does not simply mean "stored" but instead relates to the capacity to legitimately copy, play, or present the data within a hub network.

While the Examiner may apply the broadest "reasonable" meaning to the terms for the purposes of anticipation and obviousness with respect to known terms, with respect to definiteness and unknown terms, the analysis must look to the specification.

Accordingly, given the definitions from the specification, the terms and claims are sufficiently definite.

Claims 1, 6, 7, 8, and 9 have been amended to overcome the indefiniteness issue identified in paragraphs 11-19 of the Office Action.

Accordingly, Applicant respectfully requests that the rejections applied to claims 1-20 under 35 U.S.C. § 112 be withdrawn.

§103 Rejection of Claims 1-20

Claims 1-20 have been rejected under 35 U.S.C. § 103 as obvious over U.S. Patent Pub. 2003/0135464 to Mourad et al. ("Mourad").

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In order to allege that a claim is obvious when references are combined under 35 U.S.C. § 103(a), the combination must teach each and every limitation of the claim.

However, prior to establishing whether the reference teaches every limitation in the claims, the claims must be properly interpreted. In the present case, claim 1 recites "wherein the discrete license is not bound to said hub network; disabling said discrete

instance; and enabling a bound instance to bind ...” However, the Office Action fails to properly interpret the terms “discrete instance” and “bound instance.”

“A patentee can be his own lexicographer provided the patentee's definition, to the extent it differs from the conventional definition, is clearly set forth in the specification.” *Beachcombers v. Wildewood Creative Prods., Inc.*, 31 USPQ2d 1653, 1656 (Fed. Cir. 1994). “For claim construction purposes, the description may act as a sort of dictionary, which explains the invention and may define terms used in the claims.” *General Electric Co. v. Nintendo Co.*, 50 USPQ2d 1910, 1914 (Fed. Cir. 1999); MPEP § 2173.05(a)(II).

Generally, an applicant for a patent is entitled to select the claim language as long as the meaning is reasonably plain and specific. *Ellipse Corporation v. Ford Motor Company*, 312 F.Supp. 646, 660, 164 USPQ 161, 171 (N.D. Ill. 1969). Furthermore, even in the case where the claim language diverges from its ordinary meaning, **the terminology in the specification governs**. *In re Morris*, 127 F. 3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997); See also *Honeywell Int'l v. Universal Avionic Sys. Corp.*, 493 F.3d 1358, 83 USPQ2d 1425 (Fed. Cir. 2007) and *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250, 48 USPQ2d 1117, 1122 (Fed. Cir. 1998); MPEP § 804 (a).

Claim 1 recites “...disabling said discrete instance; and enabling a bound instance to bind said discrete locked content data to said hub network at the server as source locked content data.” At issue is the definition of the terms “discrete instance” and “bound instance” as they apply to the present claims. “Discrete instance” and “bound instance” are not ordinary terms in the computer science art, and therefore have no

specific known meaning. However, these terms are defined in the specification in paragraph 0033 as provided:

[0032] ... an instance that is compliant with hub network operation is in one of two exclusive states: discrete or bound. **A discrete instance is independent of any hub network and can be played or presented through any compliant device (according to the license of the discrete instance).** However, a compliant device cannot make a usable copy of a discrete instance. A discrete instance includes locked content data and a discrete license. The locked Content data of the discrete instance is referred to as the "discrete version" of the locked content data. The locked content data is locked by being protected from unauthorized access, such as by encryption. **A bound instance is bound to one hub network. The bound instance is one logical instance represented by locked content data and corresponding licenses stored on the server of the hub network and on zero or more of the clients of the hub network.** The locked content data stored by the server is the source for copies of the content data in the hub network and is the "source version." Copies of the source version content data are stored on clients and are "sub-copy versions" (though some or all of the data in the discrete version, the source version, and/or any of the sub-copy versions can be the same). **A bound instance can only be played or presented through a compatible compliant device that is a member of that hub network. Members of that hub network can make sub-copies of the content data of a bound instance.**

The above citation to the application clearly distinguishes the "discrete instance" and "bound instance." Furthermore, claim 1 intentionally uses these different terms due to their disparate meanings.

The Office Action, however, takes the position that "there is no relationship established between these [discrete and bound] instances. Therefore, one of ordinary skill in the art would not understand whether the instances represent modified versions of the same content and associated files, copies of the same content and associated files, or unrelated content and files. Therefore, one of ordinary skill in the art would not

understand if the "source locked content data" and "root license" are related to the "discrete locked content data" and the "discrete license." Because the interrelation of the parts is not set forth in the claims, one of ordinary skill in the art would not understand the metes and bounds of this claim." The Office Action then takes the contradictory position of reading the specification but only applying arbitrary points of the provided definition given these terms despite the fact that the specification gives numerous examples of the distinctions between discrete and bound instances.

From the cited passages above, it is clear that there are two types of instances taught by Applicants - discrete and bound - differ. Discrete instances are not bound to any hub network and can be moved from one device to another using compliant media, in and out of the hub network. Additionally, compliant media will not create a copy of a discrete instance. In contrast, bound instances are bound to a single hub network. A bound instance can only be played or presented through a compatible compliant device that is a member of that hub network. Members of that hub network can make sub-copies of the content data of a bound instance.

Mourad fails to teach or suggest "...disabling said discrete instance; and enabling a bound instance to bind said discrete locked content data to said hub network at the server as source locked content data." Mourad fails to properly provide any comparable elements to the "discrete instance" and "bound instance" elements recited in claim 1.

While Mourad discloses the user of encryption keys and the use of encrypted content, there is no comparable element to the discrete instance which is independent of the hub network, and any comparable element to a bound instance that is only playable

within the hub network.

Accordingly, Mourad fails to teach or suggest the elements of amended claim 1, and that claim 1 is therefore allowable. Dependent claims 2-20 and 71 inherit the patentability of independent claim 1, and are thus also allowable over Mourad.

Accordingly, Applicant requests that a notice of allowance be issued for the pending claims.

Accordingly, it is submitted that the rejection of claims 1-20 based upon 35 U.S.C. §103 (a) has been overcome by the present remarks and withdrawal thereof is respectfully requested.

Conclusion

In view of the foregoing, applicants respectfully request reconsideration of claims 1-20 and 71 in view of the remarks and submit that all pending claims are presently in condition for allowance.

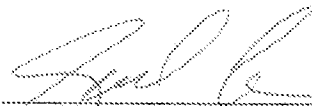
In the event that additional cooperation in this case may be helpful to complete its prosecution, the Examiner is cordially invited to contact Applicant's representative at the telephone number written below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 50-2075.

Respectfully submitted,

Dated: 2-24-10

By: _____


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